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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/537,286 | 06/01/2005 | Masashi Gotoh | 273043US3PCT | 1853 |
| 22850 | 7590 | 06/30/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | HARRISON, MONICA D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2813 | |

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/537,286

Applicant(s)

GOTOH ET AL.

Examiner

Monica D. Harrison

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Odaira et al (5,600,103).

2. Regarding claim 1, Odaira et al discloses a method for manufacturing an electronic part characterized by that a layer having a uniform thickness is formed by forming a conductor portion (Figure 1, reference 2) on a surface of a support member (Figure 1, reference 1), bringing an insulating sheet (Figure 1, reference 4) into contact with said conductor portion from above, and pressing said insulating sheet to the height of said conductor portion using said conductor portion as a stopper to make the height of said insulating sheet equal to the height of said conductor portion (Figure 5a, column 11, lines 1-48).

3. Regarding claim 2, Odaira et al discloses a method for manufacturing an electronic part characterized by that a layer having a uniform thickness is formed by forming a conductor portion (Figure 1, reference 2) on a surface of a support member (Figure 1, reference 1), bringing an insulating sheet (Figure 1, reference 4) into contact with said conductor portion

from above, pressing said insulating sheet to the height of said conductor portion using said conductor portion as a stopper to make the height of said insulating sheet equal to the height of said conductor portion (Figure 5a; column 11, lines 1-48), and then detaching said conductor portion and said insulating sheet from said surface (Figure 7a).

4. Regarding claim 5, Odaira et al discloses wherein a thermoplastic insulating sheet is used as said insulating sheet (Figure 1, reference 4).

5. Regarding claim 6, Odaira et al discloses wherein heating is performed in addition to said pressing (column 1, lines 56-62).

6. Regarding claim 7, Odaira et al discloses an electronic part comprising at least, a conductor portion (Figure 1, reference 2) having an interior completely filled up and rising from vertically from a surface of a support member (Figure 1, reference 1) and an insulating layer (Figure 1, reference 4) surrounding the circumference of said conductor portion and having a thickness equal to said conductor portion, said conductor portion and said insulating layer forming a layer having a uniform thickness.

7. Regarding claim 8, Odaira et al discloses an electronic part comprising, at least, conductor portion (Figure 1, reference 2) having an interior completely filled up and rising from vertically from the bottom of a support member (Figure 1, reference 1) and an insulating layer (Figure 1, reference 4) surrounding the circumference of said conductor portion and having a thickness equal to said conductor portion, said conductor portion and said insulating layer forming a layer having a uniform thickness.

8. Regarding claim 9, Odaira et al discloses wherein said conductor portion is formed by plating (column 13, lines 46-67)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odaira et al (5,600,103) in view of Yamaguchi et al (6,930,388 B2).

9. Regarding claims 3 and 4, Odaira et al discloses a support member (Figure 1, reference 1), a conductor portion (Figure 1, reference 2), an insulating sheet (Figure 1, reference 4) and detaching said conductor portion and said insulating sheet from said surface (Figure 5a; column 11, lines 1-48). However, Odaira et al does not disclose the power supply film (claim 3) nor the B-stage sheet (claim 4).

Yamaguchi et al discloses the power supply film (column 3, line 5; Figure 4, reference 16)) and the B-stage sheet (column 2, lines 56-60; *B-stage sheet is a thermosetting resin that has been cured*).

It is obvious, at the time the invention was made, for one having ordinary skill in the art, to modify Odaira et al, with the teachings of Yamaguchi et al, for the purpose of creating a semiconductor device having a protective film over its conductive elements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica D. Harrison whose telephone number is 571-272-1959.

The examiner can normally be reached on M-F 7:00am-3:30pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica D. Harrison
AU 2813

mdh
June 26, 2006


CARL WHITEHEAD, JR.
SUPERVISORY PATENT EXAMINER
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